

REMARKS

Please reconsider the application in view of the following remarks. Applicant thanks the Examiner for carefully considering this application.

Claim Amendments

Claims 1, 3, 4, 6, 9, 11, 12, 17, 19, and 20 have been amended to more clearly recite the invention. Support for the claim limitations may be found at least in the embodiments disclosed in the specification. In addition, claims 2, 10, and 18, have been cancelled. No new matter has been added. Applicant respectfully reserves the right to re-assert canceled claims in the future in this, or another co-pending application claiming the benefit of this Application's filing date.

Claim Objections

Claims 3, 9, and 19 were objected to as containing informalities. The claims have been amended to recite "less than 100%" in order to clarify that both a continuous and discontinuous phase are present. Claim 6 has been amended to properly depend from claim 5. The Applicant thanks the Examiner for the numerous suggestions and careful review of this application.

Rejections Under 35 U.S.C. §112

Claims 9-16 stand rejected under 35 U.S.C. §112 as failing to comply with the written description requirement. This rejection is respectfully traversed. The Applicant directs the Examiner to page 6, lines 23-26, which states that the poly-carboxylic fatty acids may include the acid, dimers, trimers, tetramers, and mixtures of the acids. Further, claims 1, 9, and 17, have been amended to more clearly recite the scope of the present invention. Specifically,

claim 9 has been amended to be commensurate with limitations found in claim 1. Should the Examiner still have any confusion, the undersigned respectfully requests that the Examiner call the undersigned. Withdrawal of this §112 rejection is respectfully requested.

Further, claims 9-16 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claim 9 has been amended to correct typographical errors occurring in the claims. Claim 10 has been cancelled, rendering the rejection of that claim moot. Withdrawal of the rejection is respectfully requested.

Rejection Under 35 U.S.C. §102(b)

Claims 1-6 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,994,660 ("Reddie"). To the extent that the rejection still applies to the claims as amended, the rejection is traversed. As amended, claim 1 recites a drilling fluid comprising an oleaginous fluid comprising about 70% to less than 100% by volume of the drilling fluid, wherein the oleaginous fluid is the continuous phase of the drilling fluid; a non-oleaginous fluid, wherein the non-oleaginous fluid is the discontinuous phase of the drilling fluid; a primary emulsifier, wherein the primary emulsifier is in sufficient concentration to stabilize the invert emulsion; a rheology modifier, wherein the rheology modifier is selected from the group consisting of a dimer poly-carboxylic C12 to C22 fatty acid, trimer poly-carboxylic C12 to C22 fatty acid, tetramer poly-carboxylic C12 to C22 fatty acid, mixtures of these acids, and polyamide wherein the polyamide is the condensation reaction product of a C12-C22 fatty acid and a polyamine selected from the group consisting of diethylenetriamine, triethylenetetramine; tetraethylenetetramine and pentaethylenetetramine wherein, the polycarboxylic fatty acid is a mixture of poly-carboxylic acids added in sufficient concentration so that the trimeric

polycarboxylic fatty acid concentration in the drilling fluid is greater than 0.1 pounds per barrel and is up to 5.0 pounds per barrel.

Applicant respectfully asserts Reddie does not disclose or suggest each and every limitation of rejected claim 1. Under Federal Circuit precedent, a rejection under 35 U.S.C. §102(b) is improper when the cited reference does not contain each and every element of the rejected claim. *See Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001).

As amended, claim 1 recites that the oleaginous fluid comprising about 70% to less than 100% by volume of the drilling fluid, which is disclosed in at least examples 1 to 4 of the specification as filed. In contrast, all of the specific embodiments disclosed by Reddie relate to compositions wherein the oil phase constitutes 50% or less of the emulsion. *See e.g.*, col. 2 lines 66-70, and Examples 1-4 of the specification. As such, Reddie is only enabling prior art to those compositions where water is at least 50% of the emulsion. In contrast, claim 1 now recites a fluid wherein at least 70% by volume is oil. The Applicant respectfully asserts that the prior art is not enabling to any other composition, and may not be used as the basis for a §102 rejection.

In addition, Reddie fails to disclose the specific limitation that the mixture of poly-carboxylic be acids added in sufficient concentration so that the *trimeric* polycarboxylic fatty acid concentration in the drilling fluid is greater than 0.1 pounds per barrel and is up to 5.0 pounds per barrel. Reddie is silent on controlling the concentration of the trimeric species, as recited in the instant claims. Therefore, the §102 rejection of claim 1 is untenable, and must be withdrawn.

Various other §102 rejections have been proffered by the Examiner. None the remaining §102 rejections, however, reject claim 2. As the limitations of claim 2 have been incorporated into claim 1, all of the remaining §102 rejections have been rendered moot. Withdrawal of all of these rejections is respectfully requested.

Rejections Under 35 U.S.C. §103

Claims 9-14 and 17-20 stand rejected as being obvious over Reddie in view of WO 89/11516. To the extent that this rejection applies to the claims as amended, the rejection is respectfully traversed. The arguments set forth with respect to Reddie above are reasserted with respect to claim 9. Particularly, the limitations that are not shown by Reddie, specifically control of the trimer concentration, are also not shown, nor are they suggested by WO 89/11516. WO 89/11516 does not provide what is lacked by Reddie. Therefore, whether taken alone or in combination, Reddie and WO 89/11516 do not show or suggest all of the elements of claim 9.

Moreover, the Applicant refutes the Examiner's position that simply because the use of organophilic clays is known in the art of drilling fluids, claim 9 is rendered obvious. In order to render the instant claims obvious, the prior art must suggest the desirability of the specific combination set forth in the claims. The Examiner has failed to show why one of ordinary skill in the art would be motivated to modify the composition of Reddie (which, as set forth above, fails to provide all of the claimed elements anyway) to include the organophilic clay found in WO 89/11516. Thus, the §103 rejection is untenable and must be withdrawn.

Claims 1 and 7-8 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 3,728,277 ("Foley") in view of Reddie. To the extent that this rejection applies to the amended claims, it is respectfully traversed. In particular, the Examiner asserts that

although the concentration range in claim 7 is not shown or suggest by the prior art, it would be obvious, simply through routine optimization. The Applicant respectfully disagrees with the Examiner's characterization that the amounts specifically recited in the claim involve mere routine work. Further, the Applicant notes that the process used in claim 8 effects the underlying structure, and therefore should be considered a limitation on the scope of the claim. *See Atlantic Thermoplastics Co., Inc. v. Faytex Corp.*, 970 F.2d 834 (Fed. Cir. 1992).

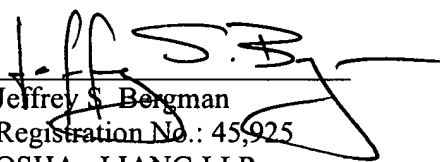
Thus, based on the reasoning set forth above, the §103 rejections of these claims is untenable and must be withdrawn.

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 05542.073001).

Dated:

9/6/05

Respectfully submitted,

By 
Jeffrey S. Bergman
Registration No.: 45,925
OSHA · LIANG LLP
1221 McKinney St., Suite 2800
Houston, Texas 77010
(713) 228-8600
(713) 228-8778 (Fax)
Attorney for Applicant

Attachments